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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/711,391	09/15/2004	Chi-Cheng Ju	MTKP0083USA	5390
27765	7590	03/26/2009		
NORTH AMERICA INTELLECTUAL PROPERTY CORPORATION P.O. BOX 506 MERRIFIELD, VA 22116			EXAMINER AN, SHAWN S	
			ART UNIT 2621	PAPER NUMBER
			NOTIFICATION DATE 03/26/2009	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

winstonhsu.uspto@gmail.com  
Patent.admin.uspto.Rcv@naipo.com  
mis.ap.uspto@naipo.com.tw

<b>Office Action Summary</b>	<b>Application No.</b> 10/711,391	<b>Applicant(s)</b> JU, CHI-CHENG	
	<b>Examiner</b> SHAWN AN	<b>Art Unit</b> 2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 21-23 is/are pending in the application.
- 4a) Of the above claim(s) 21-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **SUPPLEMENTAL ACTION**

### ***Response to Amendment***

1. As per Applicant's instruction as filed on 12/08/08, claims 13-20 have been canceled, and claims 21-23 have been newly added.

### ***Response to Applicant's newly added claims after Applicant's filing of Response to Restriction/Election***

2. Applicant's election without traverse of the Group I corresponding to claims 1-12, in the reply filed on 5/12/08 has been acknowledged.

Applicant has newly added claims 21-23. However, upon further review, newly added claims 21-23 contain modified subject matters, which are not presented in the elected group of claims 1-12.

Furthermore, examination of the additional claims 21-23 create undue burden on the Office due to additional/extra prior art searching and prosecution.

Moreover, Applicant states that the newly added claims 21-23 are modified version of the original claim 1 (Applicant's response filed on 12/08/08).

Therefore, since Applicant has elected the Group I pertaining to claims 1-12, and newly added claims 21-23 comprise the subject matter(s), which are conceptually out of boundary (due to modification) with respect to elected claims 1-12, the claims 21-23 are now treated as being withdrawn (non-elected) claims.

This response is now deemed proper and is therefore made FINAL.

### ***Response to Remarks/Arguments***

3. Applicants' Remarks as filed 12/08/08 have been fully considered and they are found to be persuasive. An updated prior art search has been made. As per potential allowance of the currently pending claims, the Applicant has to overcome (by an amendment) the following new grounds of rejection and all of the currently withdrawn (non-elected) claims must be canceled.

***Claim Rejections - 35 USC § 101***

**4.** 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**5.** Claims 1-12 are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention.

Claim 1 pertains to a video decoding method directed to a series of steps drawn for storing at least one previous product in a memory ..., determining which block to use as a prediction block ..., reading from the memory at least one previous product ..., and calculating at least one quantized AC coefficient of the current block without practical application that produces *any useful, tangible, and concrete results*. Since dependent claims 2-12 are directed to further limitations based on the video decoding method of claim 1, claims 1-12 as a whole do not fall within the statutory classes set forth in 35 U.S.C. 101.

**6.** Claims 1-12 are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention.

Supreme Court precedent<sup>1</sup> and recent Federal Circuit decisions<sup>2</sup> indicate that a statutory “process” under 35 U.S.C. 101 must (1) be tied to another statutory category (such as a particular apparatus), or (2) transform underlying subject matter (such as an article or material) to a different state or thing. While the instant claim(s) recite a series of steps or acts to be performed, the claim(s) neither transform underlying subject matter nor positively tie to another statutory category that accomplishes the claimed method steps, and therefore do not qualify as a statutory process. For example, independent claim 1 is directed to a video decoding method directed to a series of steps

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<sup>1</sup> *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

<sup>2</sup> *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

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drawn for storing at least one previous product in a memory ..., determining which block to use as a prediction block ..., reading from the memory at least one previous product ..., and calculating at least one quantized AC coefficient of the current block without any ties to a particular apparatus/structure. Since dependent claims 2-12 are directed to further limitations based on the video decoding method of claim of 1, claims 1-12 as a whole do not fall within the statutory classes set forth in 35 U.S.C. 101.

*1 Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parkerv. Flook*, 437 U.S. 584,588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876).

*2 In reBilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

### **Conclusion**

7. The prior art made of record is considered pertinent to Applicant's disclosure.

A. Uz et al (5,650,860), Adaptive quantization.

8. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to *Shawn An* whose telephone number is 571-272-7324.

9. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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**10.** The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

/SHAWN AN/

Primary Examiner, Art Unit 2621

3/22/09